

REMARKS

Claims 1-8

Claim 1 is an independent claim, from which claims 2-8 ultimately depend. Claims 1-4 and 6-8 been rejected under 35 USC 102(b) as being anticipated by Kane (6,112,014). Claim 5 has been rejected under 35 USC 103(a) as being unpatentable over Kane in view of Yoshiura (5,854,693). Applicant submits that as amended, claim 1 is patentable over Kane, such that all the still pending claims of claims 2-8 are patentable over Kane.

Claim 1 has been amended to incorporate the limitations of claim 3, in which the at least one output port is configured to electrically couple to the at least one external output device, and claim 3 has been cancelled. Claim 1 has also been amended to include a controller that “is to electrically couple to a peripheral device external to and separate from the photocopier.” The controller is “to receive image data from the peripheral device,” where this image data is “preformatted for the at least one external output device.” The controller is further “to transmit the image data received from the peripheral device to the at least one external output device.” As such, “the at least one external output device print[s] the image data.” Support for this amendment is found in the patent application as filed at least in paragraph [0019].

Applicant now briefly discusses what the whole of claim 1 is directed to by virtue of these amendments. You have a photocopier, which is electrically connected to “at least one external output device” (e.g., like a printer) as well as to “a peripheral device [e.g., like a storage device like a floppy disk, and so on] external to and separate from the photocopier.” That is, the output device and the peripheral device are not *part of* the photocopier; they are not *internal* to the photocopier. Rather, the output device is *external* to the photocopier. Likewise, the peripheral device is *external* to and *separate from* the photocopier. These are not integrated devices, in other words.

Now, the controller *receives* image data from the peripheral device. The image data is specifically limited as being “*preformatted* for the at least one external output device.” That is,

for instance, the image data is not “formatted by the controller,” as alternatively described in paragraph [0019] of the patent application as filed. Thus, the controller transmits this image data received from the peripheral device – without having to format the image data (since it is *preformatted*) – to the *external* output device, which prints the image data. That is, it is the external output device, and not the photocopier itself, which prints the image data. Therefore, claim 1 is limited to a photocopier that receives preformatted image data from a peripheral device external to and separate from the photocopier, and that transmit this image data to an external output device, which prints the image data.

Applicant submits that Kane does not teach or disclose these added limitations to claim 1. First, consider the peripheral device of claim 1, which is *external to* and *separate from* the photocopier. By comparison, the photocopier of Kane includes a peripheral device, such as a floppy disk drive, hard disk drive, or optical ROM device, that is *internal to* and/or *part of* the photocopier 10, as depicted in FIG. 5. This is particularly shown in FIG. 3, for instance, where a floppy disk drive and an optical disc drive are depicted as representative of storage means 30, and where “the photocopy machine . . . comprises . . . storage means 30.” (Col. 3, ll. 63-67) In other words, at a minimum, the peripheral devices of the photocopier of Kane are *part of* the photocopier, and are not *separate from* the photocopier, as in claim 1.

Second, image data is not *received from* these peripheral devices of Kane, in contradistinction to claim 1. Rather, the peripheral devices are intended to store image data that is generated by the photocopier. That is, in claim 1, the photocopier *receives* image data from a peripheral device, whereas Kane’s photocopier *transmits* image data (generated within the photocopier) for storage on the peripheral device. Thus, Kane’s “invention includes various storage means 30 designed for storing an image scanned by the scanning means 20,” such as “a digital copy of an image scanned by the scanning means 20.” (Col. 4, ll. 5-9) Likewise, “the copying machine 10 includes a storage means that is removable” to “allow[] a user to take a digital copy of the image scanned on the invention to other machines such as a computer to use

the scanned digital image in programs on the remote computer.” (Col. 4, ll. 10-18) Thus, the peripheral device is employed in a different way in Kane as compared to as in claim 1.

Third, image data received from an external peripheral device in Kane is not transmitted to an external output device for printing the image data, in contradistinction to claim 1. Rather, the only image data that is transmitted to an external output device for printing in Kane is image data that is generated internally by Kane’s photocopier, as opposed to image data received from a peripheral device external to and separate from the photocopier. For instance, the “transmitting means 50 is designed to permit transmission of an image scanned by the scanning means 20 to an outside source” like “a printer.” (Col. 4, ll. 25-28) “This way the image can be downloaded directly from the invention to a separate printer for printing the image.” (Col. 4, ll. 28-31) Thus, image data received from an external peripheral device is never printed on an external output device in Kane, unlike as in claim 1; instead, just image data that is internally generated by the scanning means 20 of the photocopier of Kane is printed on an external output device.

Fourth, the image data in claim 1 is *preformatted* for the external output device prior to receipt by the photocopying machine from the peripheral device. That is, as noted above, the image data does not have to be formatted within the photocopying machine for printing by the external output device, since the image data is already *preformatted* for the external output device. Kane does not disclose any of this, inasmuch as in the first instance, it does not disclose any type of image data that is received by its photocopying machine from a peripheral device that is external to and separate from the photocopying machine.

For any of these reasons, Kane does not teach or disclose all the limitations of claim 1, as amended, and therefore does not anticipate claim 1.

Claims 9-18

Claim 9 is an independent claim, from which claims 10-18 ultimately depend. Claims 9-14 and 16-18 have been rejected under 35 USC 102(b) as being anticipated by Yoshiura. Claim 15

has been rejected under 35 USC 103(a) as being unpatentable over Yoshiura in view of Kato. Applicant submits that as amended, claim 9 is patentable over Yoshiura, such that claims 10-18 are also patentable at least because they depend from a patentable base independent claim.

Claim 9 has been amended so that the method further includes “receiving image data from a peripheral device external to and separate from the image processing system” where “the image data [is] preformatted for the external output device.” The peripheral device is specifically “a storage device without printing capability and without telecommunications capability”; see, e.g., paragraph [0019] of the patent application as filed, which discusses the peripheral device being a hard disk drive, a floppy disk drive, or an optical disc drive like a CD-ROM or DVD-ROM drive, all of which are understood by those of ordinary skill within the art as at least normally not having printing capability nor telecommunications capability. The method further “transmit[s] the image data received from the peripheral device to the external output device,” where “the external output device print[s] the image data.” In this respect, claim 9 has been amended similar to the manner in which claim 1 has been amended. Therefore, discussion of what the amendments to claim 9 mean for claim 9 as a whole is not duplicated herein, and instead reference should be made to claim 1 above.

Applicant submits that Yoshiura does not teach or disclose these added limitations to claim 9. First, consider the peripheral device of claim 9, which is a storage device without printing capability, and that is external to and separate from the image processing system in question. Now, in rejecting claim 18 on page 12 of the office action, the Examiner seems to have identified the peripheral device of Yoshiura as either one of the digital copying machines (that receives data from another digital copying machine) or a modem. In this respect, Applicant requests clarification as to what element of Yoshiura corresponds to the peripheral device of claim 9. In either case, however, the peripheral device of claim 9 does not read on Yoshiura. The peripheral device of claim 9 does not have printing capability, such that the digital copying machine of Yoshiura cannot be considered the peripheral device of claim 9. Likewise, the

peripheral device of claim 9 does not have telecommunications capability, such that the modem of Yoshiura cannot be considered the peripheral device of claim 9. Thus, Yoshiura cannot anticipate claim 9 for at least this reason.

Second, the image data that is received from the peripheral device in claim 9 and transmitted to the external output device is specifically image data that is *preformatted* for the external output device. Applicant has reviewed Yoshiura in detail, and cannot find any reference to whether or not its image data is *preformatted* or formatted by the external output device and/or by the image processing system itself. Therefore, at a minimum, Yoshiura is silent as to this limitation, and thus cannot anticipate claim 9 for this reason. For both of these reasons, Yoshiura does not render claim 9 unpatentable.

Claims 19-23

Claim 19 is an independent claim, from which claims 20-23 ultimately depend. Claims 19-20 and 22-23 have been rejected under 35 USC 102(b) as being anticipated by Kane. Claim 21 has been rejected under 35 USC 103(a) as being unpatentable over Kane in view of Kato (7,180,623). Applicant submits that as amended, claim 19 is patentable over Kane as well as over Kane in view of Kato, such that all the still pending claims of claims 20-23 are patentable at least because they depend from a patentable base independent claim. In particular, claim 19 has been amended similar to the manner in which claim 1 has been amended insofar as the rejection over Kane is concerned, and therefore is patentable for at least substantially the same reasons that claim 1 is patentable, as has been discussed above.

Claims 24-25

Claim 24 is an independent claim, from which claim 25 ultimately depends. Claims 2 and 25 have been rejected under 35 USC 102(b) as being anticipated by Yoshiura. Applicant submits that as amended, claim 24 is patentable over Yoshiura, such that claim 25 is patentable at least

because it depends from a patentable base independent claim. In particular, claim 24 has been amended similar to the manner in which claim 9 has been amended insofar as the rejection over Yoshiura is concerned, and therefore is patentable for at least substantially the same reasons that claim 9 is patentable, as has been discussed above.

Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mike Dryja, Applicants' Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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